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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,569	09/09/2003	George Emanuel	KSY 02655 PTUS	3413
32233	7590	01/19/2010	EXAMINER	
STORM LLP BANK OF AMERICA PLAZA 901 MAIN STREET, SUITE 7100 DALLAS, TX 75202			KIM, CHRISTOPHER S	
			ART UNIT	PAPER NUMBER
			3752	
			NOTIFICATION DATE	DELIVERY MODE
			01/19/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/658,569	Applicant(s) EMANUEL, GEORGE	
	Examiner Christopher S. Kim	Art Unit 3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-65 and 68-78 is/are pending in the application.
- 4a) Of the above claim(s) 68 and 77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-65, 69-76 and 78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 14, 2009 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Applicant elected Invention I, Species A (figures 1-3) in the reply filed on November 4, 2005. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Claims 68 and 77 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 4, 2005.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 59-65, 69-76, 78 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 59 recites the limitation "...each orifice injecting iodine at right angles to a tangent to a curvature of a strut surface at the orifice" in lines 17-18 that was not disclosed at the time the application was filed.

Claim 70 recites a similar limitation in lines 11-13.

7. Claims 59-65, 69-76, 78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 59 recites the limitation "the exit plane" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Claim 59 recites the limitation "the laser cavity" in line 17. There is insufficient antecedent basis for this limitation in the claim.

Claim 59 recites "An iodine injection system for injecting iodine into gas flowing through a nozzle for a laser comprising:..." The preamble indicates that the intended

Art Unit: 3752

use of the iodine injection system is for injecting iodine into a gas flowing through a nozzle for a laser. The preamble suggests that the "gas," "nozzle" and "laser" are not positively recited limitations/elements of the iodine injection system. The preamble appears to be in conflict with the body of the claim which suggests that the nozzle and laser cavity are elements within the injection system.

The term "proximate" in claim 60 is a relative term which renders the claim indefinite. The term "proximate" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is uncertain what distance is defined by the claim.

Claim 60 recites the limitation "gas flowing through the nozzle" in line 2. There is insufficient antecedent basis for this limitation in the claim. The "gas flowing through the nozzle" is not a positively recited limitation in parent claim 59.

Claim 63 recites the limitation "the iodine" in line 2. There is insufficient antecedent basis for this limitation in the claim. The "iodine" is not a positively recited limitation in parent claim 59.

Claim 69 recites the limitation "gas flowing through the nozzle" in line 2. There is insufficient antecedent basis for this limitation in the claim. The "gas flowing through the nozzle" is not a positively recited limitation in parent claim 59.

Claim 70 recites "An iodine injection system for injecting iodine into gas flowing through a nozzle for a laser comprising:..." The preamble indicates that the intended use of the iodine injection system is for injecting iodine into a gas flowing froth a nozzle

for a laser. The preamble suggests that the "gas," "nozzle" and "laser" are not positively recited limitations/elements of the iodine injection system. The preamble appears to be in conflict with the body of the claim which suggests that the nozzle and gas flow are elements within the injection system.

Claim 70 recites the limitation "when the system is in use" in line 13. The preamble is directed to an apparatus but the body of the claim appears to recite a use limitation. The claim is indefinite because:

- (1) the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. MPEP 2173.05(q).

Claim 70 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

- (2) the claim appears to encompass two statutory classes of invention.
MPEP 2173.05(p).

The term "proximate" in claim 70 is a relative term which renders the claim indefinite. The term "proximate" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the

art would not be reasonably apprised of the scope of the invention. It is uncertain what distance is defined by the claim.

The term "proximate" in claim 71 is a relative term which renders the claim indefinite. The term "proximate" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is uncertain what distance is defined by the claim.

Claim 72 recites the limitation "the kernel region" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 72 recites the limitation "the exit plane" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 73 recites the limitation "the exit plane" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 74 recites the limitation "the iodine" in line 2. There is insufficient antecedent basis for this limitation in the claim. The "iodine" is not a positively recited limitation in parent claim 70.

Claim 75 recites the limitation "the carrier gas" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 76 recites the limitation "the carrier gas" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 78 recites the limitation "gas flowing through the nozzle" in line 2. There is insufficient antecedent basis for this limitation in the claim. The "gas flowing through the nozzle" is not a positively recited limitation in parent claim 70.

Response to Arguments

8. Applicant's arguments filed December 14, 2009 have been fully considered but they are not persuasive.

Applicant argues that the components of the "system" include a nozzle, at least one strut and orifices arrayed in the strut. The preamble of claims 59 and 70 indicates the contrary. Applicant should amend the preamble to reflect the intended scope of the claimed invention. Applicant is reminded of the elected invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (571) 272-4905. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on (571) 272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3752

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Christopher S. Kim/
Primary Examiner, Art Unit 3752

CK